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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/142,983	09/18/1998	JEFFREY-R. JACKSON	P50464-1	2930

7590 10/01/2002

SMITHKLINE BEECHAM CORPORATION  
CORPORATE INTELLECTUAL PROPERTY-UW2220  
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EXAMINER

CRIARES, THEODORE J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/01/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/142,983  
Filing Date: September 18, 1998  
Appellant(s): JACKSON ET AL.

Paper No. 15

**MAILED**

**OCT 01 2002**

**GROUP 2900**

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Dara L. Dinner  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 23, 2002.

**(1) *Real Party in Interest***

Art Unit: 1617

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because claims 13-17 are drawn to "use" of compounds. This terminology renders the claims none-statutory under 35 U.S.C. 101..

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

Art Unit: 1617

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 7-9 and 13-17 are rejected under 35 U.S.C. first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is a lack of an antecedent basis for the phrase ""and wherein the compounds were invented after the priority date of March, 26, 1996" relating to future unknown compounds. There is no basis for such terminology in the specification and would not reasonable convey to one skilled in the relevant art that the inventor had possession of the claimed invention. Applicant argues that the claims can encompass narrower limitations than supported by the specification.

However, the language as set forth above renders the claims indefinite since it is claiming compounds which are not presently in existence. In essence the applicant is claiming a perpetual motion machine, which is not patentable.

The appellants' statement in the brief that certain claims do not stand or fall together is not agreed with because claims 13 to 17 recite "use of" compounds which render the claims non-statutory under 35 U.S.C. 101.

**11) *Response to Argument***


Art Unit: 1617

Appellants Brief does not contain an argument upon which the examiner rejected claims 1-4, 7-9 and 13-17, but argues the issue as "new matter". Therefore, it is deemed that applicant has acquiesced to the Examiner's rejection. The examiner's rejection is directed to the lack of support in the specification for the language set forth in the claims relating to compounds a) invented after March 26, 1996; b) other than those compounds disclosed before March 26, 1996; c) were invented after March 26, 1996; and d) wherein the compound was used before or invented after the priority date of March 26, 1996.

The claims on appeal are allowable if the above language, not present in the specification, is deleted.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

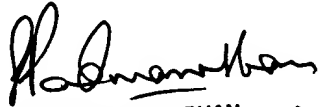
  
Theodore J. Criares  
Primary Examiner  
Art Unit 1617

T.J.C.  
September 27, 2002

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9/27/02